

Notice of Allowability

Application No.

09/560,397

Examiner

Isaac M Woo

Applicant(s)

BOYER ET AL.

Art Unit

2162

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 08/28/2004.
2. ☒ The allowed claim(s) is/are 1-5,8,10-14,17,19-23 and 26.
3. ☒ The drawings filed on 28 April 2000 are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413), Paper No./Mail Date _____
7. ☐ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

JEAN M. CORRIELUS
PRIMARY EXAMINER

DETAILED ACTION

1. Claims 1-5, 8, 10-14, 17, 19-23 and 26 are presented for examination. This office action is in response to the amendment filed on August 28, 2004.

Allowable Subject Matter

2. Claims 1-5, 8, 10-14, 17, 19-23 and 26 are allowed.

Reason For Indicating Allowable Subject Matter

3. The following is a statement of reasons for the indication of allowable subject matter: Claims 1, 10 and 19 identifies distinct feature, the computer method, computer program product and computer system for determining potential licensees for a source patent portfolio. The closest prior art, Rivette et al (U.S. Patent No. 5,991,751), discloses devising a set of associated patents wherein each patent in the get of associated patents i) cites as a reference a patent in the source patent portfolio or ii) is cited a reference by a patent in the source patent portfolio; processing all of the patents in the set of associated patents to establish a set of assignees contained in the set of associated patents; establishing a set of remaining assignees by removing from the set of assignees all assignees that are currently licensed. Rivetts does not address the organizing the set of remaining assignees according to a ranking criteria that causes a

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higher ranking to be given to any assignee when the following ratio is greater for that assignee than for other assignees, wherein the ranking criteria gives more weight to assignees both having patents that have a reference to a patent in the source patent portfolio and having patents that are cited as reference by a patent in the source patent portfolio. Thus, Rivetts fails to suggest the claimed limitation as mentioned above in combination with other limitations of the dependent claims. The invention is allowable over the prior art for being directed to a combination of claimed element as indicated above.

Claims 2-5, 8, 11-14, 17, 20-23 and 26, further depending from the claims 1, 10 and 19, are allowed with the same reason above.

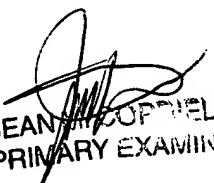
Conclusion

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Isaac M Woo whose telephone number is (571) 272-4043. The examiner can normally be reached on 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E Breene can be reached on (571) 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

IMW
November 5, 2004


JEANNE COPPELUS
PRIMARY EXAMINER